

U.S. Serial No. 10/614,037

REMARKS

Claims 1-48 are pending in this application. Claims 1-33 and 37-45 have been withdrawn by the examiner. Applicants cancel claims 1-33 and 37-45 without prejudice or disclaimer. Claim 36 is amended to correct informalities. Claims 46-48 are new. The new claims are dependent on claims of the elected group XI and are fully supported by the original specification. See specification, for example, page 4, at 14 and page 5, at 17 for claims 46-47 and 48, respectively. Therefore, no new matter has been added. The Office Action is discussed below:

Obviousness Rejection:

On pages 2-4 of the office action, the examiner has rejected claims 34-36 allegedly as being unpatentable over Price *et al.* (WO 98/15614) in view of Kistner *et al.* (US 5,753,489). Applicants respectfully disagree on the obviousness rejection, because the examiner has failed to establish a *prima facie* case of obviousness.

To establish a *prima facie* case of obviousness, three criteria must be met. First, there must be some motivation or suggestion to make the proposed combination or modification of the references. Second, there must be a reasonable expectation of success. Further, "the teaching or suggestion to make the claimed combination must be found in the prior art, and not based on the applicant's disclosure." MPEP 2142 (Rev. 3, August 2005), discussing *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). In addition, the combined, or modified, references must teach or suggest all claim limitations. See also MPEP §§ 2143-2143.03 (Rev. 3, August 2005). Applicants submit that the rejection do not meet this test.

According to the examiner, Price discloses "a methods of culturing cells comprising providing a culture cell that have been grown in an animal protein free medium comprising soy hydrolysate at a concentration of about .1% and yeast hydrolysate at a concentration of 0.1% to about .8% (pages 19-20)." Applicants respectfully disagree with the examiner and indicate that the term "soy hydrolysate" is not even described on pages 19-20 of the Price disclosure. Applicants also indicate

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that Price discloses an animal cell culture medium formulation that contains at least one plant peptide and/or plant lipids and/or fatty acids for cultivation of animal cells (see Price et al. Abstract).

Applicants point out that Price et al. at page 19-20, as indicated by the examiner on page 3 of the Office Action, does not disclose the concentration of soy or yeast hydrolysate according to the claimed invention. Applicants also point out that Price et al. at page 24, does not disclose the term "kidney cells", as indicated by the examiner on page 3 of the Office Action.

On page 4 of the Office Action, the examiner states that "[o]ne would have been motivated to do so by the disclosure of Price et al. that the method avoids contamination by animal proteins", however, the examiner has not identified where in the reference the motivation to combine with Kistner is present. Accordingly, the examiner has not adequately explained the alleged motivation needed to establish a *prima facie* case.

Applicants further submit that Price does not suggest nor motivate one of ordinary skilled in the art to arrive at the claimed invention of a culture medium comprising soy hydrolysate and yeast hydrolysate, because, Price suggested to use "rice peptide" instead of "soy and/or yeast extracts." More specifically, applicants quote from Price that "[t]hese results demonstrate that, of the plant peptides tested as supplements for the culture media, the hydrolysate of rice performed most optimally.the results obtained with rice peptide supplementation were significantly higher than those obtained with either soy or yeast extracts......Thus, rice hydrolysate is favored as a supplement in animal protein-free formulations of culture media suitable for the cultivation of animal cells." (see Price et al. page 31, lines 9-16). Clearly, there is no motivation nor any suggestion in Price et al. to use soy hydrolysate or yeast hydrolysate. In fact, Price teaches away from the claimed invention of use of a culture medium comprising soy hydrolysate and/or yeast hydrolysate. Therefore, one of ordinary skilled in the art would not have been motivated, at the time the instant

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application was filed, to combine the formulation as suggested by Price and the formulation of Kistner to arrive at the claimed invention.

Applicants also submit that the combination of Price and Kistner is nowhere supported by the references or in the common knowledge of the art. Accordingly, the rejection calls to mind the Federal Circuit decision of *In re Rouffet*, 149 F.3d 1350 (Fed. Cir. 1998), where the court explained:

As this court stated, "virtually all [inventions] are combinations of old elements." *Environmental Designs, Ltd. v. Union Oil Co.*, 713 F.2d 693, 698, 218 USPQ 865, 870 (Fed. Cir. 1983); see also *Richdel, Inc. v. Sunspool Corp.*, 714 F.2d 1573, 1579-80, 219 USPQ 8, 12 (Fed. Cir. 1983) ("Most, if not all, inventions are combinations and mostly of old elements"). Therefore an examiner may often find every element of a claimed invention in the prior art. If identification of each claimed element in the prior art were sufficient to negate patentability, very few patents would ever issue. Furthermore, rejecting patents solely by finding prior art corollaries for the claimed elements would permit an examiner to use the claimed invention itself as a blueprint to defeat the patentability of the claimed invention. Such an approach would be an "illogical and inappropriate process by which to determine patentability." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570, 38 USPQ2d 1551, 1554 (Fed. Cir. 1996).

To prevent the use of hindsight based on the invention to defeat patentability of the invention, this court requires the examiner to show motivation to combine the references that create the case of obviousness. In other words, the examiner must show reasons that the skilled artisan, confronted with the same problems as the inventors and with no knowledge of the claimed invention, would select the elements from the cited prior art references for combination in the manner claimed.

In re Rouffet, 149 F.3d 1350, 1357 (Fed. Cir. 1998).

Applicants submit that the rejection does not satisfy the strictures of the *Rouffet* decision. The references are not combinable without proscribed hindsight.

In addition, applicants indicate that Kistner *et al.* (US 5,753,489) do not rectify the deficiencies of Price *et al.* (WO 98/15614). Thus, a combination of Price and Kistner does not make the claimed inventions obvious.

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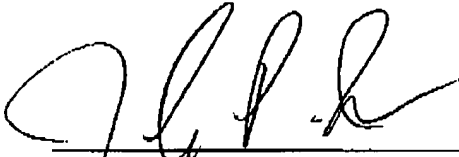
Therefore, withdrawal of the obviousness rejection is solicited.

REQUEST

Applicants submit that the claims are in condition for allowance, and respectfully request favorable consideration to that effect. The examiner is invited to contact the undersigned at (202) 416-6800 should there be any questions.

Respectfully submitted,

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Date



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